

REMARKS

The Applicants have now had an opportunity to carefully consider the comments set forth in the Office Action mailed August 8, 2006, the Advisory Action mailed November 28, 2006 and the telephone conference of December 1, 2006. All of the rejections are respectfully traversed. Amendment, reexamination and reconsideration of the application are respectfully requested.

The Office Action

In the Office Action mailed August 8, 2006:

A response to the arguments characterized by the Office Action as having been filed on 30 May 2006, which were mailed by the Applicants on May 26, 2006 was provided;

claims 1-18, 20 and 23 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite;

claims 1-7, 16, 17 and 19-23 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,516,157 to Maruta, et al. ("Maruta"); and,

claims 8-15 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Maruta.

Telephone Interview Summary

The participation of the Examiner, Mr. Stefanos Karmis, in a brief telephone conference with Mr. Thomas Tillander, one of the representatives of the Applicants, on or about December 1, 2006, is noted with appreciation. During that conversation, Mr. Tillander noted that the reason given in the Advisory Action for refusing entry of the Applicants' previous amendment (Amendment E) is related to the amendment of claim 22 presented therein. Accordingly, Mr. Tillander asked if a similar paper, that did not include the amendment to claim 22, would be entered. The Examiner indicated that such a paper would be entered. It is respectfully submitted that this amendment (Applicants' Amendment F) is such a paper. Accordingly, entry and reexamination and reconsideration are respectfully requested.

Reply to Response to Arguments

The Office Action asserts that Applicants' argument that the phrase

“arbitrarily” is definite under 35 U.S.C. 112, second paragraph, is not persuasive and further asserts it would not be obvious to one of ordinary skill in the art to “determine qualifications for an arbitrarily long list of aspects.” However, the Applicants and the U.S. Patent and Trademark Office respectfully disagree.

For example, after a brief search, the Applicants found approximately twenty issued patents that include the phrase “arbitrarily long” in respective claims thereof

Claims 1 and 8 of U.S. Patent No. 6,999,891 B2 make reference to a system that “generates **arbitrarily long** test data on the data lines according to the test pattern.” Claim 2 of the same patent recites that the test pattern is **arbitrarily long**.

Claims 4 and 18 of U.S. Patent No. 6,959,309 B2 include recitation related to “**arbitrarily long** file names.”

Claims 6, 7 and 8 of U.S. Patent No. 6,538,488 B2 recite “**arbitrarily long** durations.”

Claim 1 of U.S. Patent No. 6,507,920 B1 recites an “interconnect having an **arbitrarily long** length.”

Claims 5 and 10 of U.S. Patent No. 6,300,888 B1 recite an “entropy encoder used to assign variable length entropy codes to **arbitrarily long** sequences of coefficients.” Claim 29 of the same patent recites “a method of encoding an **arbitrarily long** series of audio input coefficients.”

Claim 3 of U.S. Patent No. 6,298,453 B1 recites “running one of the first and second oscillator for an **arbitrarily long** period of time.”

Claim 8 of U.S. Patent No. 6,084,535 recites “the maximum number of consecutive zeroes in even or odd bit positions at the output of the partial response channel is **arbitrarily long**.”

Claim 4 of U.S. Patent No. 5,761,698 recites “said AV/CD controller/coprocessor performs **arbitrarily long** sequences of graphics operations.”

Claim 1 of U.S. Patent No. 5,654,542 recites “a method of generating a broad band signal of **arbitrarily long** duration.”

Claim 11 of U.S. Patent No. 5,568,614 recites “a streaming device adaptor controlling a device performing operations requiring processing of **arbitrarily long** data streams.”

Element (c) of claim 9 of U.S. Patent No. 5,558,774 recites “maintaining a temperature in the range from 50°C - 60°C, and substantially constant HRT over

and **arbitrarily long** time.”

Element (e) of claim 1 of U.S. Patent No. 5,488,908 recites “wherein said electrically activated detonator means and said firing and control circuitry can be directly interconnected for an **arbitrarily long** period of time before providing said high voltage.” Element (d) of claim 3 recites “interconnecting said electrically activated detonator means and said firing and control circuitry for an **arbitrarily long** period of time before providing said high voltage.” Claims 4 and 5 recite “**arbitrarily long** leads.”

Claim 21 of U.S. Patent No. 5,448,561 recites “thereby permitting transmissions of **arbitrarily long** messages.”

Claim 4 of U.S. Patent No. 5,181,191 recites “wherein said input and output scan registers and any internal scan registers in the data propagation paths are (a) serially operated pursuant to a first clock that can have an **arbitrarily long** period to serially scan test values.” Claim 8 recites “operating the internal scan registers in the data propagation paths in the serial mode pursuant to a series of cycles of a first clock that can have an **arbitrarily long** period to serially scan in scan registered test values.”

Claims 1 and 4 of U.S. Patent No. 4,385,350 each recite “several processors, each having an **arbitrarily long** unique logical address.”

Claims 2 and 3 of U.S. Patent No. 4,253,114 each recite “the time-chopped scrambling sequence having an **arbitrarily long** repetition cycle.”

Claim 3 of U.S. Patent No. 4,108,543 recites “means for arresting said adjustable rotary member at an open rest position thereof for making **arbitrarily long** exposures during a time interval between the end of a film advancement and the activation of said primary control means.”

Claim 4 of U.S. Patent No. 4,065,666 recites “a plurality of said systems each deposited on a separate chip to operate on **arbitrarily long** operands.”

Claim 1 of U.S. Patent No. 3,793,541 recites “said guiding structure having a guiding strength that provides **arbitrarily long** path lengths in said fluid medium in the presence of thermal effects.”

Claim 7 of U.S. Patent No. 3,249,097 makes reference to “an **arbitrarily long** marina system structure.” Claim 12 refers to “an **arbitrarily long** deck assembly slab.”

Accordingly, it is respectfully submitted that the phrase "arbitrarily long" is understood by the U. S. Patent and Trademark Office and is not indefinite. Therefore, it is respectfully submitted that **claims 1-18, 20 and 23** are definite and particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Withdrawal of the rejections under 35 U.S.C. 112, second paragraph, is respectfully requested.

With regard to **claims 1-23**, section 7 of the Office Action indicates that the Office is not giving any patentable weight to the recitation of a configurable billing system in the preamble of the claims and asserts that there are no limitations in **claim 1** in which configuring a billing system is performed.

However, **claim 1** is a system claim and not a method claim. Accordingly, **claim 1** recites system components which are useful for configuring a billing system and not a procedure for configuring a billing system. Moreover, **claim 1** recites system components which are not anticipated by Murata. For example, **claim 1** recites a coded billing strategy and a plurality of meters whereby the billing system tallies the aspects in a manner defined in the billing strategy. Furthermore, the coded billing strategy includes an arbitrarily long list of aspects of interest and an arbitrarily long list of meter descriptions defined for the machine. The machine and the aspects of interest are first mentioned in the preamble.

It is respectfully submitted that Murata does not disclose a coded billing strategy including a arbitrarily long list of aspects of interest and an arbitrarily long list of meter descriptions defined for the machine and a plurality of meters updated by the billing system for recording the delivery of the aspects of the product or service based on the billing strategy, whereby the billing system tallies the aspects in a manner defined in the billing strategy.

Additionally, or alternatively, it is respectfully submitted that "a claim preamble has the import that the claim as a whole suggests for it," *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). Furthermore, the body of the claim relies on the preamble to provide a proper antecedent basis for --the machine-- and --aspects of the product or service--. Accordingly, the body of the claim does depend on the preamble for completeness (see *In re Hirao*, cited by the Office Action), and it is respectfully submitted that the recitation of a configurable billing system should be

given patentable weight.

For at least the foregoing reasons, **claim 1**, as well as **claims 2-5**, which depend therefrom, is not anticipated by Maruta.

Claim 6 also recites a configurable billing system. The system includes a billing strategy description, a plurality of meters defined in the billing strategy and a billing module operative to update the plurality of meters according to the billing strategy description. Accordingly, arguments similar to those submitted in support of **claim 1** are submitted in support of **claim 6**. Maruta does not disclose or suggest a system including a billing strategy description. Moreover, even if Maruta could be construed as disclosing a system including a billing strategy description, Maruta does not disclose or suggest a system including a billing strategy description including an arbitrarily long list of aspects of interest and/or an arbitrarily long list of meter descriptions which is accessible by a billing system. Moreover, Maruta does not disclose or suggest a billing module operative to update a plurality of meters according to a billing strategy description.

Additionally, or alternatively, the body of **claim 6** depends on the preamble to provide an antecedent basis for --the billing system--. Therefore, the body of the claim depends on the preamble for completeness, and the preamble should be accorded patentable weight.

Claim 16 recites *inter alia*: a configurable billing system operative to follow a billing strategy specification including an arbitrarily long list of document production events of interest, an arbitrarily long list of meter descriptions and a machine-readable script for updating the meters defined in the list to record the occurrence of document production events as described in the billing strategy specification.

The portion of the Office Action directed to **claim 16** does not address the recitation of a configurable billing system. It is respectfully submitted that Maruta discloses a system fixed with four counters. The billing system of Maruta is not configurable. Additionally, Maruta does not disclose or suggest a billing strategy specification including an arbitrarily long list of document production events of interest or an arbitrarily long list of meter descriptions. Furthermore, Maruta does not disclose or suggest a billing strategy including a machine-readable script for updating the meters defining the list.

It is respectfully submitted that one of ordinary skill in the art would

understand the phrase --machine-readable script--. Additionally, it is respectfully submitted that one of ordinary skill in the art would not construe Maruta as disclosing or suggesting a billing strategy specification including a machine-readable script for updating the meters defined in a list.

Further in this regard, it is respectfully submitted that claim 9 of U.S. Patent No. 6,839,715 B1 recites a human-readable script. Claims 1, 4, 7, 11, 13 and 22 of U.S. Patent No. 6,595,781 recite generating and storing digitally-readable script files or uses or inclusions thereof. Accordingly, it is respectfully submitted that one need not read limitations from the specification into the phrase --machine-readable script-- in order to understand the scope of **claim 16** and that Maruta does not disclose or suggest a machine-readable script or a billing strategy specification including a machine readable script for updating meters defined in a list.

For at least the foregoing reasons, it is respectfully submitted that **claim 16**, as well as **claims 17** and **18**, which depend therefrom, is not anticipated and is not obvious in light of Maruta.

Claim 19 recites a method for developing and using a universal billing module, the method comprising predefining a billing strategy specification, the billing strategy specification including a list of parameters with implicit or explicit communication mechanisms and data parsing information and process algorithm information in the form of *inter alia*: a machine-readable script, storing the billing strategy specification in a machine-readable form, reading the stored billing strategy specification and instantiating meter data structures as directed by the read billing strategy specification. It is respectfully submitted that Maruta does not disclose or suggest at least these elements of **claim 19**. Additionally, arguments similar to those submitted above with regard to **claim 16** are submitted in support of **claim 19**. Maruta does not disclose or suggest a machine-readable script or a machine-readable script included in a billing strategy specification. Furthermore, it is not necessary to read limitations from the specification into the phrase --machine-readable script-- for one of ordinary skill in the art to come to this conclusion. Accordingly, it is respectfully submitted that **claim 19**, is not anticipated and is not obvious in light of Maruta.

Claim 20 recites a configurable billing system for a machine. The body of the claim depends on the preamble for antecedence and, therefore, completeness.

Accordingly, the preamble, including the recitation of a configurable billing system should be given patentable weight. Additionally, the body of the claim recites *inter alia*: a custom billing strategy file including an arbitrarily long list of aspects of interest and an arbitrarily long list of meter descriptions defined for the machine, a means for loading the custom billing strategy file and a plurality of meters instantiated by the billing system for recording the delivery of the aspects of the product or service based on the billing strategy. It is respectfully submitted that Maruta does not disclose or suggest a custom billing strategy file or a means for loading a custom billing strategy file. Moreover, Maruta does not disclose or suggest a custom billing strategy file including an arbitrarily long list of aspects of interest or an arbitrarily long list of meter descriptions or a plurality of meters instantiated by the billing system based on the billing strategy.

For at least the foregoing reasons, it is respectfully submitted that **claim 20** is not anticipated and is not obvious in light of Maruta.

Arguments similar to arguments submitted in support of **claims 1** and **19** are submitted in support of **claim 21**. **Claim 21** recites a coded billing strategy description accessible by the billing system, including a machine-readable script. The body of **claim 21** depends on the preamble or antecedence and, therefore, completeness. Accordingly, the preamble should be accorded patentable weight. Furthermore, Maruta does not disclose or suggest a coded billing strategy description accessible by the billing system, including a machine-readable script. Additionally, **claim 21** recites a plurality of meters defined in the machine-readable script as mathematical functions of information received from one or more aspect sensors. It is respectfully submitted that Maruta does not disclose or suggest a plurality of meters defined in a machine-readable script, or defined in a machine-readable script as mathematical functions of information received from one or more aspect sensors. Similar arguments are submitted with respect to the recitation of a billing module of **claim 21**.

For at least the foregoing reasons, **claim 21** is not anticipated and is not obvious in view of Maruta.

Claim 22 recites a document processing system comprising *inter alia*: a configurable billing system operative to run a machine-readable script received in a billing strategy file, the machine readable script being operative to, at least one of,

instantiate and update a set of meters for recording the occurrence of document production.

It is respectfully submitted that Maruta does not disclose or suggest a configurable billing system operative to run a machine-readable script received in a billing strategy file. Indeed, it is respectfully submitted that Maruta does not disclose or suggest a configurable billing system. Moreover, it is respectfully submitted that Maruta does not disclose or suggest receiving machine-readable script or receiving a machine-readable script in a billing strategy file. Furthermore, Maruta does not disclose or suggest a machine-readable script being operative to, at least one of, instantiate and update a set of meters.

For at least the foregoing reasons, **claim 22** is not anticipated and is not obvious in view of Maruta.

Additionally, claim 22 recites a configurable billing system. The Office Action indicates that the recitation of --configurable billing system-- was not given any patentable weight with regard to **claim 1** because it occurs in the preamble. That the Office Action includes this assertion and does not include a rebuttal of the merits of the Applicants' earlier assertion that Maruta does not disclose or suggest a configurable billing system suggests that the Office recognizes that Maruta does not disclose or suggest a configurable billing system.

In this regard, it is noted that claim 22 recites a configurable billing system in the body of the claim. Even if the Office were justified in not giving the phrase --configurable billing system-- patentable weight in **claim 1** (which is disputed), it is respectfully submitted that the phrase --configurable billing system-- must be given patentable weight in **claim 22**.

For at least the foregoing additional reasons, **claim 22** is not anticipated and is not obvious in light of Maruta.

Claim 23 recites a document processor comprising *inter alia*: a billing strategy file defining a billing strategy in machine-readable form, the billing strategy file describing an arbitrarily large number of mathematical functions of an arbitrarily large number of meters for processing and recording information recorded by the at least one aspect sensor and a billing module operative to receive the billing strategy file and instantiate the arbitrarily large number of meters according to the billing strategy.

It is respectfully submitted that the phrase --arbitrarily large number-- is as definitive as the phrase --arbitrarily long-- as discussed above and as included in allowed claims in patents issued by the U.S. Patent and Trademark Office. It is respectfully submitted that Maruta does not disclose or suggest a billing strategy file or a billing strategy file defining a billing strategy in machine-readable form. Moreover, Maruta does not disclose or suggest a billing strategy file describing an arbitrarily large number of mathematical functions of an arbitrarily large number of meters. Instead, the system of Maruta includes four, and only four, counters (column 9, lines 25-26). Maruta does not disclose or suggest a billing module operative to receive a billing strategy file. Moreover, Maruta does not disclose or suggest a billing module operative to receive a billing strategy file and instantiate an arbitrarily large number of meters according to the billing strategy.

It is respectfully submitted that nothing in the general references to column 9, lines 20-55; column 10, lines 43-62; and column 12, lines 12-53, cited by the Office Action, disclose or suggest a coded billing strategy, a configurable billing system, a billing strategy file, a custom billing strategy file, a predefined billing strategy specification, or a billing strategy description. It is respectfully submitted that the description of counters in the cited portion of column 9 does not disclose or suggest that the counters are described in a coded billing strategy or that such a coded billing strategy includes an arbitrarily long list of aspects of interest and an arbitrarily long list of meter descriptions. The description of steps involved in calculating a cost found in the cited portion of column 10 does not disclose or suggest a coded billing strategy or coded billing strategy including an arbitrarily long list of aspects of interest and an arbitrarily long list of meter descriptions. It is respectfully submitted that the general reference to programs and data stored on a hard disk found in the cited portion of column 12 does not disclose or suggest a coded billing strategy or a coded billing strategy including an arbitrarily long list of aspects of interest and an arbitrarily long list of meter descriptions.

Arguments similar to these are submitted with respect to the billing strategy description recited in **claim 6**, the configurable billing system and billing strategy specification recited in **claim 16**, the predefined billing strategy specification including a list of parameters with implicit or explicit communication mechanisms and data parsing information recited in **claim 19**, the custom billing strategy file

recited in **claim 20**, the coded billing strategy description, including a machine-readable script, recited in **claim 21**, the configurable billing system operative to run a machine-readable script recited in **claim 22** and the billing strategy file defining a billing strategy in machine-readable form recited in **claim 23**.

With regard to **claim 2**, it is respectfully submitted that the description in column 11, lines 51-57, of an image file does not disclose or suggest a coded billing strategy including information regarding a format in which information regarding the aspect of interest will be communicated to the billing system by the machine. Maruta does not disclose or suggest that image data will be communicated to a billing system. It is respectfully submitted that image data would not be communicated to a billing system. Even though the cited portion of column 11 includes the word --format--, the cited portion of column 11 does not disclose or suggest a coded billing strategy further comprising information regarding a format in which information regarding the aspect of interest will be communicated to a billing system by a machine.

Column 10, lines 23-34, of Maruta discuss the scanning and analysis of an image set in a predetermined position on a glass platen. It is respectfully submitted that the cited portion of column 10 does not disclose or suggest that meters are included in a list of meters. Moreover, the cited portion of column 10 does not disclose or suggest that a meter is described as a function of at least one of the listed aspects of interest as recited in **claim 3** of the present application.

Column 10, lines 43-53, describe a printing cost calculation. However, the cited portion of column 10 does not disclose or suggest that a coded billing strategy includes information associated with listed meters, the information describing the function of the meters as recited in **claim 4**.

Column 10, lines 14-21, mention clearing a memory area corresponding to the cost storage in RAM 102. However, it is respectfully submitted that disclosure of clearing a memory area does not disclose or suggest a plurality of meters are instantiated in memory by a billing system according to a coded billing strategy as recited in **claims 5 and 7** of the present application.

For at least the foregoing additional reasons, **claims 2-5 and 7** are not anticipated and are not obvious in light of Maruta.

Claim 17 depends from **claim 16** and is not anticipated and is not obvious for

at least that reason.

With regard to **claims 8-15 and 18**, the Office Action asserts that Applicants' arguments failed to comply with 37 CFR 1.111(b) because they amount to a general allegation of the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes from the references. However, the rejections in question stipulate that Maruta fails to specify other aspects of interest, such as impression count, impression flag, set count, set completion flag, diagnostic impression flag, media descriptor, highlight color flag or full color flag. Since the Office Action stipulated that Maruta fails to disclose these aspects, which are recited, for example, in **claims 8-15** of the present application, there was no need for the Applicants to specifically point out how the language of the claims patentably distinguishes from the reference. The Official Notice taken by the previous Office Action, which amounts to a general allegation that the claims do not define a patentable invention without specifically pointing out a reference that is combinable with Maruta, is respectfully traversed.

For at least the foregoing additional reasons, **claims 8-15 and 18** are not anticipated and are not obvious in light of Maruta.

The Claims are Definite

Claims 1-18, 20 and 23 rejected under 35 U.S.C. §112, second paragraph, as being indefinite for including the term "arbitrarily." However, as indicated above, the phrase --arbitrarily long-- is a term of art and has been included in claims of patents issued by the U.S. Patent and Trademark Office. In the context of the present application, one of ordinary skill in the art would understand the meaning of the phrase --arbitrarily long list-- and --arbitrarily large number-- as recited in **claims 1-18, 20 and 23**. In addition to the arguments presented above, in reply to the Response to Arguments, the attention of the Examiner is directed to the arguments presented in Applicants' Response D in regard to the previous rejections under 35 U.S.C. §112, second paragraph.

For at least the foregoing reasons, **claims 1-18, 20 and 23** are definite and particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Accordingly, withdrawal of the rejections under U.S.C. §112, second paragraph, is respectfully requested.

The Claims are not Anticipated

Claims 1-7, 16, 17 and 19-23 were rejected under 35 U.S.C. §102(e) as being anticipated by Murata. These rejections were first presented in the previous Office Action.

Accordingly, in addition to the arguments submitted above, the attention of the Examiner is directed to the arguments presented in Applicants' Response D, which was mailed on May 26, 2006.

For at least the foregoing reasons, **claims 1-7, 16, 17 and 19-23** are not anticipated in view of Murata.

The Claims are not Obvious

Claim 8-15 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Murata. These rejections were presented in the previous Office Action.

Accordingly, in addition to the arguments submitted above with regard to **claims 8-15 and 18**, the attention of the Examiner is directed toward arguments in support of **claims 8-15 and 18** presented in Applicants' Response D, which was mailed on May 26, 2006.

For at least the foregoing reasons, **claims 8-15 and 18** are not anticipated in light of Murata.

Telephone Interview

In the interests of advancing this application to issue the Applicant(s) respectfully request that the Examiner telephone the undersigned to discuss the foregoing or any suggestions that the Examiner may have to place the case in condition for allowance.


CONCLUSION

Claims 1-23 remain in the application. **Claim 21** has been amended to add a comma. The amendment of **claim 22**, that is objected to in the Advisory Action that was mailed November 28, 2006, is not included in this amendment. Accordingly, entry of this amendment and prosecution on the merits is respectfully requested. For at least the foregoing reasons, the claims are now in condition for allowance. Accordingly, an early indication thereof is respectfully requested.

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & McKEE, LLP

Dec 5, 11, 2006
Date


Joseph D. Dreher, Reg. No. 37,123
Thomas Tillander, Reg. No. 47,334
1100 Superior Avenue, 7th Floor
Cleveland, Ohio 44114-2579
(216) 861-5582

N:\XERZ\200346\US\VIEW\0005177V001.doc